

Appin. No. 10/707,984
Docket No. 140804/GEM-0097

REMARKS / ARGUMENTS

The following status and remarks are presented in view of the Advisory Action dated January 20, 2006, where the Examiner states that for purposes of appeal the proposed amendments of Applicant's Reply dated January 3, 2006, will be entered. Accordingly, the claim listing presented above reflects the entry of the January 3, 2006, proposed amendments.

Status of Claims

Claims 1, 4-10, 13, 16 and 19-20 are pending in the application. Claims 1, 4-10 and 20 are allowed. Claims 13, 16 and 19 stand rejected. Applicant appreciates the Examiner's comments regarding the allowance of the noted claims. Applicant herein amends Claim 13, leaving Claims 1, 4-10, 13, 16, and 19-20 for consideration upon entry of the present Amendment.

Applicant respectfully submits that the rejections under 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

These amendments and accompanying remarks were not presented earlier because Applicant did not fully appreciate the nature of the Examiner's position until the Applicant was advised in more detail of the position by the advisory action. The claim amendments presented herein, which Applicant respectfully requests entry thereof, should require only a cursory review by the Examiner as they include only elements presented in earlier examined claims. Accordingly, such amendments should not require further consideration or search.

Rejections Under 35 U.S.C. §103(a)

Claims 13, 16 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chappo (U.S. Patent No. 6,510,195, hereinafter Chappo) in view of Luhta et al. (Conference paper entitled "Back Illuminated Photodiodes for Multislice CT", hereinafter Luhta).

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Claim 19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Chappo and Luhta, as applied to Claim 13 above, and further in view of Doubrava et al. (U.S. Patent No. 6,512,809, hereinafter Doubrava).

Applicant traverses these rejections for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention in such a manner as to perform as the claimed invention performs. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

Regarding Claims 13, 16 and 19

Applicant has amended Claim 13 to now recite, inter alia,

"...wherein the array of backlit photodiodes includes neighboring backlit photodiodes having a cell-to-cell signal crosstalk of equal to or less than about 2% in response to the first layer having a uniform thickness of equal to or less than about 100 microns."

In the Advisory Action Paper No. 20060112, dated January 20, 2006, the Examiner comments that "Claim 13 and associated dependent claims do not include uniform thickness limitation, as argued by applicant and incorporated by applicant into claim 1."

In view of the allowability of Claim 1 in combination with the Examiner's aforementioned comments, Applicant submits that Claim 13 is now directed to allowable subject matter, as the cited References fail to establish a prima facie case of obviousness.

Arguments that the cited References fail to establish a prima facie case of obviousness are presented in Applicant's Response filed January 3, 2006, and are therefore not repeated here, but are alternatively herein incorporated by reference in their entirety.

In view of the foregoing, Applicant submits that the References fail to teach or

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suggest each and every element of the claimed invention and are therefore wholly inadequate in their teaching of the claimed invention as a whole, fail to motivate one skilled in the art to do what the patent Applicant has done, fail to offer any reasonable expectation of success in combining the References to perform as the claimed invention performs, and discloses a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a), which Applicant considers to be traversed.

Applicant has amended the claims for presentation in better form for consideration on appeal. The claim amendments should only require a cursory review by the Examiner as they only include language presented in earlier examined claims.

In light of the foregoing remarks and amendments, Applicant respectfully submits that the proposed amendments and arguments comply with 37 C.F.R. §1.116 and should therefore be entered, and with their entry that the Examiner's rejections under 35 U.S.C. §103(a) have been traversed, and that the application is now in condition for allowance. Such action is therefore respectfully requested.

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The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 07-0845.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-identified Deposit Account.

Respectfully submitted,

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